



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,970	11/09/2001	Philip J. Passantino	301098	3787

28264 7590 01/12/2006

BOND, SCHOENECK & KING, PLLC
ONE LINCOLN CENTER
SYRACUSE, NY 13202-1355

EXAMINER

GLASS, RUSSELL S

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/035,970	Applicant(s) PASSANTINO, PHILIP J.	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: The claim fails to commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material, (MPEP 608.01(m)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1 –12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. As per claim 1, subsections (g) through (h) all disclose limitations that describe the intended result of the claimed method steps. For example, claim 1, subsection (g) discloses “assisting the client in automatically capturing and uploading information, from a database, in a format that will allow the server to encrypt and secure”. This excessive verbiage makes the scope of the claim indefinite because it is unclear who must do what to complete the claimed method step. A separate method step of encrypting and/or securing with a server, following the step of automatically capturing and uploading information would be helpful in resolving the indefiniteness issue.

Subsections (h)-(k) have the same indefiniteness issue as subsection (g) because the gerund phase initiating the method step is followed by an infinitive that describes an intended result rather than clearly defining an affirmative method step. This claim structure renders these subsections indefinite for the same reasons provided in the example of subsection (g).

4. As per claim 3, the claim discloses a Markush group from which a database is selected. It is unclear to the examiner how the following group members: world wide web, e-mail, gopher, specialty physician referral, specialty hospital referral, patient medical record referral, and client/payor constitute a database.

Furthermore, Claim 3 contains the trademark/trade name Gopher. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a database and, accordingly, the identification/description is indefinite.

5. As per claim 7, the claim initially claims that a 'graphical user interface provides items...". The Markush group describing those items contains the gerund phrase

Art Unit: 3626

"displaying client information" as an item included in the group. It is unclear whether "displaying" pertains only to client information or to other group members as well.

6. As per claim 9, it is unclear how the method step of tracking can comprise a "hospital center of excellence". Furthermore, a "hospital center of excellence" is considered in itself to be a statement of indeterminate scope because it is unclear what facilities would qualify as excellent.

7. Claims 2, 4-6, 8, 10-12 all depend from rejected claims and are therefore rejected for the same reasons as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-8, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg, (U.S. Pub. 2002/0065682) in view of Stephanou, (U.S. 6,505,166).**

9. As per claim 1, Goldenberg discloses a computerized method of recruiting and credentialing a network of specialized experts and storing this information for electronic consultations to be used by clients comprising:

a) providing a secure and limited access to a client by the use of a networked computer system, (Goldenberg, Fig. 3; ¶¶ 9, 42, 47) (passwords providing secure and limited access);

Art Unit: 3626

- b) displaying selected information to the client, (Goldenberg, ¶ 10, 50) (selected professional resumes are displayed);
- c) providing means to select a specialized expert in response to an inquiry, search or other request being made by the client, (Goldenberg, ¶¶ 15, 50-53, 67)(patient approval of expert is required);
- d) receiving and processing a request from a client and displaying said information about a selected expert to the client, (Goldenberg, ¶¶ 15, 50-53, 67) (information including field of expertise);
- e) accessing the profile of the selected expert, (Goldenberg, ¶¶ 15, 50-53, 67)(a resume is considered to be a profile);
- f) providing specific inquiries to the client, said specific inquiries generated by the selected expert, (Goldenberg, ¶¶ 15, 50-53, 67);
- g) assisting the client in automatically capturing and uploading information, from a data base, in a format that will allow the server to encrypt and secure the information for transmission to the designated expert, (Goldenberg, ¶¶ 15, 16, 29-33, 40) (disclosing an information retrieval system that encodes data for security purposes);
- i) retrieving any additional information previously stored for the client to appropriately confirm the identity of the client to the server and insure the security and integrity of the information to be transmitted, (Goldenberg, ¶¶ 42, 47) (the password and user I.D. would be an example of additional information previously stored);

- j) generating a request to the designated expert to obtain the specialized expertise required for the clients specific needs, (Goldenberg, ¶¶ 15, 50-53, 67) (an inquiry is considered to be a request); and
- k) tracking and fulfilling the generated request to complete the desired referral, said referral is obtained from a leading expert without the person needing to physically travel to a distant location or maintain an expensive, rare, with limited access or availability or otherwise infrequently used expertise within their local area, (Goldenberg, ¶ 15, 29, 50-53, 67).

Goldenberg fails to disclose the remaining claim limitation (h). However, such limitation is well known in the art as evidenced by Stephanou. Stephanou discloses:

- h) interfacing with the clients own systems to extract any available background or demographic information to most efficiently capture previously-stored information to minimize re-entering the information or creating data entry or transcription errors, (Stephanou, Figs. 7 and 8; col. 7, lines 23-50) (disclosing a method of asking whether to view or create ticket, wherein viewing is equivalent to capturing previously-stored information. Furthermore, name, city and e-mail address is considered to be an example of background or demographic information that is currently valid in the system, i.e., not requiring re-entry if valid).

It would be obvious to one of ordinary skill in the art to combine Goldenberg and Stephanou. The motivation would be to create a virtual help desk to provide experts in many areas of expertise immediately and competently in response to queries for help

from customers, (Stephanou, col. 2, lines 30-33).

10. As per claim 2, Goldenberg discloses a computerized method wherein said networked computer system is connected to a central telemedicine data base, (Goldenberg, ¶¶ 13, 27, 44).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

11. As per claim 3, Goldenberg discloses a computerized method wherein said data base is selected from the group consisting of the world wide web, email, gopher, specialty physician referral, specialty hospital referral, patient medical record referral, current file, archival file, and client/payor, (Goldenberg, ¶¶ 5, 9, 29, 44, 49, 52).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

12. As per claim 4, Goldenberg discloses a computerized method, wherein said server accesses said data bases, (Goldenberg, ¶¶ 47, 52).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

13. As per claim 5, Goldenberg discloses a computerized method, wherein said clients are selected from the group consisting of HMOs, PPOs, POS plans, TPAs, self-insured employers, patients, physicians, indemnity insurance carriers, and payors,

Art Unit: 3626

(Goldenberg, Title; ¶ 54) (physician is equivalent to doctor, and communication between treatment centers would involve physicians as clients).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

14. As per claim 6, Goldenberg discloses a computerized method, wherein said format further includes a graphical user interface, (Goldenberg, ¶ 10).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

15. As per claim 7, Goldenberg discloses a computerized method, wherein said graphical user interface provides items selected from the group consisting of user data requests, displaying client information, data entry forms, local validation of data, user information, demographics, scanned images, digital data, chart information, cost data, outcome measures, billing data, specialty/expertise data, location data, current data, special services data, and archival data, (Goldenberg, ¶¶ 10, 15) (disclosing user information and a user inquiry provided via a graphical user interface).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

16. As per claim 8, Goldenberg discloses a computerized method, wherein said

Art Unit: 3626

server notifies the designated specialist by means selected from the group consisting of e-mail, pager, fax, and palm pilot, (Goldenberg, ¶ 67) (disclosing notification by e-mail).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

17. As per claim 10, Goldenberg discloses a computerized method wherein said selected specialized expert is searched by a request from the client, (Goldenberg, ¶ 15, 29, 50-53, 67).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

18. As per claim 11, Goldenberg discloses a computerized method wherein said search is accessed through the Internet, (Goldenberg, ¶¶ 9, 52).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

19. As per claim 12, Goldenberg discloses a computerized method wherein said access is selected from the group consisting of a palm pilot, e-mail, and remote computer, (Goldenberg, Figs. 1,2; ¶¶ 9, 67) (disclosing access via remote computer and e-mail).

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference.

20. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg and Stephanou as applied to claim 1 above, and further in view of Brown, (U.S. 6,368,273).**

21. As per claim 9, Goldenberg discloses a computerized method wherein tracking further comprises cost and billing data of specialists, physician demographics, medical specialty, location outcome measures, and hospital centers of excellence, (Goldenberg, ¶¶ 52, 67; claim 31).

The collective system of Goldenberg and Stephanou fails to disclose a computerized method step of tracking medical efficacy. However, a computerized method step of tracking medical efficacy is well known in the art as evidenced by Brown. Brown discloses a networked system for interactive communication and remote monitoring of individuals that conducts surveillance and monitoring of pharmaceutical data such as efficacy, (Brown, col. 14, lines 54-65). It would be obvious to one of ordinary skill in the art in view of Brown to include medical efficacy in tracking data.

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 1 and incorporated herein by reference. The motivation to add Brown would be to avoid a labor-intensive patient interview, (Brown, col. 14, lines 54-65).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Falchuck et al., (U.S. 6,256,613); Itzhaki, (U.S. Pub.

Art Unit: 3626

2002/0010616); and www.bestdoctors.com, © 1998, as viewed on January 25, 1999 at:
http://web.archive.org/web/*/http://www.bestdoctors.com.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
12/22/05



C. LUKE GILLIGAN
PATENT EXAMINER